

**PETITION UNDER 37 C.F.R. § 1.144
EXPEDITED PROCEDURE
EXAMINING GROUP 2600**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named	
Inventor :	Joel R. Weiss et al.
Appln. No.:	10/734,377
Filed :	December 12, 2003
For :	MINIMIZED SKEW ANGLE SLIDER
Docket No.:	S01.12-1009
	Group Art Unit: 2627
	Examiner: Allen T. Cao

**PETITION UNDER 37 C.F.R. 1.144 TO REVIEW AND REVERSE
RESTRICTION REQUIREMENT**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**ELECTRONICALLY FILED
July 28, 2008**

Sir:

This petition is in response to the Office action dated May 28, 2008. The applicants respectfully petition the Director under 37 C.F.R. 1.144, through the Technology Center Director as the official with delegated authority, to review and reverse the restriction requirement imposed by the examiner in the present application.

**Background: The restriction requirement was improperly directed to different
embodiments of the same inventive concept**

This application was subject to a final rejection dated May 28, 2008. The applicants may defer petition until after final rejection, under 37 C.F.R. 1.144. Under 37 C.F.R. 1.181, such a petition is timely filed within two months of the mailing date of the action from which relief is requested, i.e. of the final rejection of May 28, 2008.

In an Office action dated August 7, 2006, the examiner originally indicated the claims of the present invention to be drawn to 14 different patentably distinct species, and required election

of one of those species for examination. The applicants properly and specifically traversed the requirement while making a provisional election in a response dated September 7, 2006, arguing in part that the examiner had improperly identified different embodiments as independent and distinct inventions, whereas they were different embodiments within the same inventive concept that illustratively indicate some of the breadth and variety of the inventive concept of the claims, and that there is no requirement in the law or the rules that a claimed invention be confined to a single embodiment. The identified species were such that even two figures that showed and were explicitly identified as a top plan view and a side plan view of the same embodiment, showing the same features, were identified as separate species, as in the case of figures 9 and 10, which were identified as species 4 and 5, respectively. The examiner acknowledged the applicants' election with traverse, made arguments to rebut the rationales provided for the traverse, and held the restriction requirement to be final, in a subsequent Office action dated November 22, 2006. The applicants therefore preserved their right to petition from the restriction requirement.

Remarks: The restriction requirement should be reversed at least as applied to finding claims 1-12, 24-28 and 30-32 as amended to be directed to non-elected species

In an Office action response of March 4, 2008, the applicants made certain claim amendments to the two pending independent claims, as detailed below. In the final rejection in the Office action of May 28, 2008, the examiner indicated that these claim amendments had been disregarded for purposes of the examination of the claims, for purportedly constituting a shift to non-elected subject matter. Thereafter, the examiner included a verbatim repetition of the arguments for rejection in the prior Office action, still arguing why the claims in their pre-amended form should be rejected. The final rejection is therefore based entirely on the earlier restriction requirement, and the rationale that the applicants' claim amendments are to be ignored by virtue of that restriction requirement.

However, the claim amendments added subject matter that had not been specifically recited in any prior claim, let alone in non-elected claims. Furthermore, the claim amendments

only added narrowing limitations to the claims, and therefore could not have constituted a shift to a separate, independent and distinct invention.

The subject matter in the elected claims and in the amendments made in the applicants' response of March 4, 2008 are directed to features on different sections of the same device, where the supposed independent and distinct inventions may constitute nothing more than different perspective views of a single embodiment the same device. The applicants submit that different perspective views showing different features of the same device cannot constitute independent and distinct inventions to justify a restriction requirement.

The examiner has in effect identified a wide variety of different features and embodiments of the disclosure, or in some cases even different perspective views of the exact same embodiments and same features, as all belonging to independent and distinct inventions, and then refused to consider narrowing claim amendments for examination where any elements added to the claims can be found to coincide with different aspects of the disclosure. This routine, carried to its logical conclusion, could prevent any examination of any claimed application, where the claims were not allowed in their original form, by purporting to categorize all elements outside of the original independent claims as separate species, and then disregarding any narrowing amendment at all as a purported shift to a non-elected species.

The applicants respectfully submit that this shows the rationale for the present restriction requirement to be unsustainable, and request that the Director reverse the restriction requirement at least as applied in finding the pending claims as amended to be directed to non-elected species, and direct the examiner to examine the claims as amended in the applicants' action of March 4, 2008.

Additional details of the claims and their amendments are provided as follows.

Amended claims 1 and 27 are not drawn to non-elected subject matter

The Office action of May 28, 2008 was not the first final action in the prosecution of this application. However, it was the first action in which the examiner refused to examine the claims in amended form under the rationale that the claims as amended are directed to non-statutory

subject matter; and 37 C.F.R. 1.144 indicates that applicants may defer a petition from a final requirement for restriction until after final action, but does not indicate that such a petition can only be deferred until after a first final action. Rather, Rule 144 only indicates that such a petition may be filed “after final action” in general, and not later than appeal, indicating that any final action in general may begin a new two-month period under 37 C.F.R. 1.181 for filing such a petition.

The Office action of May 28, 2008 (hereinafter “the Office action”) indicates that the subject matter added by amendment to claims 1 and 27 in the applicants’ response of March 4, 2008 (hereinafter “the prior response”) was disregarded for purposes of the Office action, as being directed to non-elected subject matter. The applicants respectfully submit that the subject matter of claims 1 and 27 as amended in the prior response is directed to subject matter that did not, in its entirety, appear in any previous claims, non-elected or otherwise, and therefore could not be drawn to a non-elected species.

The Office action indicates that the subject matter newly added to claims 1 and 27 is included in the non-elected species claims 15 and 16. However, only a portion of the newly added subject matter is actually recited in claims 15 and 16, while the totality of the newly added subject matter is not included in claims 15 and 16, or in any of the prior claims.

Specifically, claim 1 was amended in the prior response as follows, with markings reproduced to show the amended subject matter:

1. A suspension assembly comprising a suspension, a slider, and a suspension interface comprising a pivot and a pivot socket, wherein the pivot is rotatably engaged with the pivot socket, wherein the suspension interface ~~that~~ provides substantial freedom of rotation of the slider about a yaw axis relative to the suspension.

Claim 27 was amended in the prior response as follows, with markings reproduced to show the amended subject matter:

27. (Currently amended) A slider, comprising:

means for operatively suspending the slider from a suspension, the means comprising a pivot and a pivot socket, wherein the pivot is rotatably engaged with the pivot socket, wherein the means provides substantial freedom of rotation of the slider about a yaw axis; and

means for exploiting an ambient fluid flow ~~to provide substantial freedom of rotation of the slider about a yaw axis~~ to reduce a skew angle of the slider relative to the ambient fluid flow.

On the other hand, claims 15 and 16 read as follows:

15. The suspension assembly of claim 1, wherein the suspension interface comprises a pivot.

16. The suspension assembly of claim 1, wherein the suspension interface comprises a pivot socket.

Claim 15 therefore further limits claim 1 only to the extent of reciting that the suspension interface comprises a pivot, and claim 16 further limits claim 1 only to the extent of reciting that the suspension interface comprises a pivot socket. Withdrawn claim 35 recites certain analogous subject matter, but is dependent on a different parent claim, and also does not recite wherein the pivot is rotatably engaged with the pivot socket. On the other hand, claims 1 and 27 as amended also recite wherein the pivot is rotatably engaged with the pivot socket. This subject matter did not appear in any claim prior to the amendment of the prior response. Since it did not appear in any claim, it certainly did not appear in any previously non-elected claim.

Furthermore, when the restriction requirement was made, the Office indicated that claims 1 and 27 were among the claims that were generic to all indicated species (Office action of August 7, 2006, page 2, paragraph 3). The applicants submit that the Office was correct in that assessment, and that the amendments of claims 1 and 27 only further define the elected species within the scope of those originally generic claims.

Restriction of claims is improper because adding further limitations to a claimed species does not constitute a shift to a different, independent species

The applicants further submit that even if the subject matter newly added by amendment in the prior response had been limited to that of other, non-elected claims, its combination with the other subject matter of claims 1 and 27 without any subject matter being removed from claims 1 and 27 constitutes an acceptable further narrowing of the elected subject matter, not a shift to non-elected subject matter, since claims 1 and 27 are still directed to all the limitations of the elected subject matter in its original form, in addition to the narrowing amendments. (The applicants note that while some wording was struck in the amendment to claim 27, this wording was only rearranged rather than removed from the claim.) The applicants therefore respectfully submit that claims 1 and 27 as amended do not constitute independent and distinct inventions from the elected species.

While the Office action refers to 37 C.F.R. 1.142(b) and MPEP 821.03, the rule indicated therein provides only that an applicant may not shift from elected subject matter to non-elected subject matter, not that an applicant is barred from later narrowing the elected subject matter with a narrowing amendment that has any overlap with the non-elected subject matter. Rather, the opposite is the case, as MPEP 821.03 explicitly provides that “[t]he practice set forth in this section is not applicable... where applicant presents claims that could not have been restricted from the claims drawn to other elected invention had they been presented earlier.” Since the amendments to claims 1 and 27 only add further limitations to their subject matter, they do not give rise to independent and distinct inventions, and could not properly have been restricted from the original claims 1 and 27 if they had been presented earlier.

The Office action reasons that the newly amended claims are independent “or” distinct from the originally claimed invention. The applicants respectfully point out that restriction is only proper in the case of species that are both independent “and” distinct (37 C.F.R. 1.142(a)), and the Office action has explicitly applied an incorrect standard for evaluating whether restriction would be proper for claims 1 and 27 as amended. The applicants further submit that a

claim that is amended only to add further limitations that narrow its scope, rather than an amendment that eliminates some elements in exchange for others, by definition is not “independent” from the original form of that claim.

As defined by the restriction requirement, the defining elements of the elected species are directed to features associated with the air bearing surface of a slider, and the defining elements of the species of claims 14 and 15 are directed to features associated with the back surface of a slider. The differences used to try to define separate species are therefore no more than different perspective views of the same subject matter, for purposes of claims 1 and 27 in light of the previous election and amendments. Two perspective views of the same device from two different directions do not constitute two independent and distinct inventions.

The applicants therefore respectfully submit that claims 1 and 27 as amended are not directed to a new species because they are not independent from the subject matter already examined on the merits.


Conclusion: The restriction requirement should be reversed at least as applied to finding claims 1-12, 24-28 and 30-32 as amended to be directed to non-elected species

The applicants therefore respectfully request that the Director review and reverse the restriction requirement at least as applied to withdrawal from consideration of the amended subject matter of claims 1 and 27, and instead direct the examiner to examine claims 1 and 27 as amended on the merits in the applicants’ action of March 4, 2008, along with claims 2-12, 24-26, 28, and 30-32 as they incorporate the amended subject matter of claims 1 and 27.

The Director is authorized to charge any fee deficiency required by this paper or any paper in the prosecution of this application or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

By: 

Bryan F. Erickson, Reg. No. 51,655
900 Second Avenue South, Suite 1400
Minneapolis, Minnesota 55402-3319
Phone: (612) 334-3222
Fax: (612) 334-3312

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